

REMARKS

Claims 1-346 are pending in this application. Claims 65, 69, 106, 186, 187, 211, 318, and 324 are amended to correct minor matters of form and typographical errors. Support for these amendments can be found in the specification as filed. No new matter has been added by the foregoing amendments.

Restriction Requirement

The Examiner required restriction under 35 U.S.C. § 121 between the following groups of claims¹:

- | | |
|-------------|---|
| Group I: | Claims 1, 21-39, 40-49, 56-59, 66-84, and 186-189,
drawn to a composition; |
| Group II: | Claims 1-17, 339-340, drawn to a composition; |
| Group III: | Claims 1 and 50-55, drawn to a composition; |
| Group IV: | Claims 1 and 60-63, drawn to a composition; |
| Group V: | Claims 1 and 64-65, drawn to a composition; |
| Group VI: | Claims 1 and 85-87, drawn to a composition; |
| Group VII: | Claims 1 and 88-94, drawn to a composition; |
| Group VIII: | Claims 1 and 95-99, drawn to a composition; |
| Group IX: | Claims 1 and 100-104, drawn to a composition; |
| Group X: | Claims 1 and 105-107, drawn to a composition; |

- Group XI: Claims 108-168, 171-183, and 341-342, drawn to a composition;
- Group XII: Claims 108 and 169-170, drawn to a composition;
- Group XIII: Claims 108 and 190-192, drawn to a composition;
- Group XIV: Claims 108 and 193-199, drawn to a composition;
- Group XV: Claims 108 and 200-204, drawn to a composition;
- Group XVI: Claims 108 and 205-209, drawn to a composition;
- Group XVII: Claims 108 and 210-212, drawn to a composition;
- Group XVIII: Claims 213-255, 259-261, 268-271, 278-296, 343-344, drawn to a composition;
- Group XIX: Claims 213 and 262-267, drawn to a composition;
- Group XX: Claims 213 and 272-275, drawn to a composition;
- Group XXI: Claims 213 and 276-277, drawn to a composition;
- Group XXII: Claims 213, 297-299, and 323-324, drawn to a composition;
- Group XXIII: Claims 213 and 300-306, drawn to a composition;
- Group XXIV: Claims 213 and 307-311, drawn to a composition;
- Group XXV: Claims 213 and 312-316, drawn to a composition;

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

1 Applicants note that claims 18-20, 184-185, and 256-258 have not been included in any of the thirty-five (35) groups of claims recited by the Examiner. Further, the claims of Group XXXI have not been classified by the Examiner into a class or subclass.

- Group XXVI: Claims 213 and 317-319, drawn to a composition;
- Group XXVII: Claims 320, drawn to a composition;
- Group XXVIII: Claims 321 and 322, drawn to a composition;
- Group XXIX: Claims 325 and 338, drawn to a composition;
- Group XXX: Claim 326, drawn to a lipstick composition;
- Group XXXI: Claims 327 and 328, drawn to a composition;
- Group XXXII: Claims 329-333 and 336, drawn to a composition;
- Group XXXIII: Claim 334, drawn to a method for care, makeup, or treatment of a keratin material;
- Group XXXIV: Claims 335 and 337, drawn to a method of making a cosmetic composition and for providing at least one resistance to shear and stability to a cosmetic composition, respectively; and
- Group XXXV: Claims 345 and 346, drawn to a composition.

Applicants respectfully traverse the restriction requirement on the grounds that examining Groups I - XXXV together will not constitute a serious burden, that the Examiner's grouping of the claims is legally improper, and that Examiner's classification of the subject matter of the claims is procedurally erroneous. However, in order to be fully responsive to the restriction requirement, Applicants elect, with traverse, the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

invention of Group XXIX, Claims 325 and 338. Applicants respectfully request withdrawal of the restriction requirement for the reasons provided *infra*.

First, Applicants respectfully refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs the Examiner as follows

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, Applicants respectfully submit that the Examiner has not demonstrated that examining Groups I - XXXV together will constitute a serious burden, despite the Examiner's assertion that they are "not disclosed as capable of use together and they have different functions." See page 5 of the present Office Action. Applicants respectfully submit that a search of Groups I - XXXV would not be burdensome, as all of the claims recite, *inter alia*, at least one liquid fatty phase comprising at least one structuring polymer and at least one oil-soluble cationic surfactant. Thus, the search and examination of Group I should substantially, if not completely, overlap the necessary search and examination for Groups II-XXXV.

In addition, Applicants traverse the restriction requirement because the Office is attempting to improperly carve up the claimed invention. As evidenced by the election requirement set forth at page 15 of the Office Action, the Office is requiring restriction within independent claims 1, 108, and 213 (although not within, *inter alia*, elected independent claims 325 and 338). Applicants have a statutory right under 35 U.S.C. § 112, second paragraph, to claim the subject matter regarded as the invention in the

FINNEGAN
HENDERSON
FARABOW
CARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

manner Applicants choose. Issuing a restriction requirement within a claim with the idea that Applicants would have to carve up that claim and pursue the non-elected subject matter in a separate application violates this right under 35 U.S.C. § 112. Indeed, the predecessor to the Federal Circuit has characterized such action as tantamount to a refusal to examine. *In re Weber*, 198 USPQ 328 (CCPA 1978); *In re Haas*, 198 USPQ 334 (CCPA 1978). Accordingly, Applicants also traverse the restriction requirement on the ground that it is legally improper.

Finally, Applicants traverse the present restriction requirement on the additional ground that it is procedurally improper. As noted above, claims 18-20, 184-185, and 256-258 have not been included in any of the thirty-five (35) groups of claims recited by the Examiner. In addition, many of the Examiner's classifications appear to be incorrect. For example, Group XXIX, comprising composition claims 325 and 338 and which has been elected with traverse herein, is classified in class 132, subclass 204. See page 4 of the present Office Action. Class 132 is drawn to "Toilet," and the class definition recites that "this is a residual class for devices and methods used by persons in making their toilet." Subclass 204 is indented under subclass 200, "Methods," and is drawn to "Relaxing or reducing agent followed by fixing or neutralizing agent (e.g., "permanent")." Claims 325 and 338 are drawn to make-up, care and/or treatment compositions.

Further, for example, Groups IX, XVI, and XXV, comprising claims 1, 100-104, 108, 205-209, 213, and 312-316, are classified in class 424, subclass 549. Class 424 is entitled "Drug, Bio-affecting and Body Treating Compositions." Subclass 549 is indented under subclass 520 entitled "Extract, Body Fluid, or Cellular Material of

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Undetermined Constitution Derived from Animal is Active Ingredient." Subclass 549 itself is entitled "Skeleton (e.g., bone, teeth, etc.)" and comprises "[s]ubject matter in which the material is or is derived from parts of the skeleton or teeth." Applicants fail to see the connection between claims 1, 100-104, 108, 205-209, 213, and 312-316 and this subclass. Accordingly, Applicants additionally traverse the present restriction requirement on the ground that it is procedurally improper.

For at least the foregoing reasons, Applicants submit that examining Groups I - XXXV together will not constitute a serious burden and that the restriction requirement is both legally and procedurally in error. Accordingly, Applicants respectfully request that the restriction requirement withdrawn.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 26, 2002

By: 

Julie M. Seaman
Reg. No. 51,156

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

APPENDIX TO AMENDMENT OF JUNE 25, 2002

Version with Markings to Show Changes Made

IN THE SPECIFICATION:

Page 3, delete the second full paragraph, and substitute the following therefor:

-- The invention applies not only to make-up products for at least one keratinous material such as lip compositions, lip pencils, foundations including foundations which may be case in the form of a stick or a dish, concealer products, temporary tattoo products, eyeliners, and mascara bars, but also to body hygiene products such as deodorant sticks, and to care products and products for treating at least one keratinous material such as sunscreen [()](anti-sun) and after-sun products which may be in stick form and also nail products. It is to be noted that a deodorant product is a body hygiene product and does not relate to care, make-up, or treatment of keratin materials, including keratinous fibers, skin, or lips. --

Page 11, delete the fourth full paragraph, and substitute the following therefor:

--In the present invention, R^2 , which are identical or different, can, for example, each be chosen from C_{10} to C_{42} hydrocarbon-based, e.g., alkylene groups. At least 50% of all R^2 , for example at least 75% of all R^2 , which are identical or different, can, for example, each be chosen from groups comprising from 30 to 42 carbon atoms. In the two aforementioned embodiments, the remaining R^2 , which are identical or different, can, for example, each be chosen from C_4 to C_{18} groups, such as C_4 to C_{12} groups. --

Page 19, delete the second full paragraph, and substitute the following therefor:

-- Another embodiment of the invention relates to a method of making up or caring for skin, lips, or keratinous fibers comprising applying to the skin, lips, or keratinous fibers a structured composition containing at least one liquid fatty phase structured with at least one structuring polymer comprising a polymer skeleton comprising at least one hydrocarbon-based repeating unit comprising at least one hetero atom and at least one oil-soluble ester. --

Pages 21-22, delete the paragraph bridging pages 21 and 22, and substitute therefor:

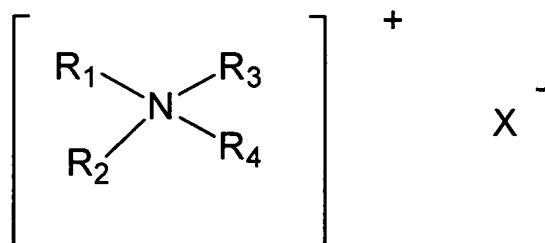
--The liquid fatty phase of the composition may contain more than 30%, for example, more than 40%, of liquid oil(s) having a chemical nature close to the chemical nature of the skeleton (hydrocarbon or silicone based) of the structuring polymer, and for example from 50% to 100%. In one embodiment, the liquid fatty phase structured with a polyamide-type skeleton, or polyurea, or [polyurethan]polyurethane, or polyurea-urethane-type skeleton contains a high quantity, i.e., greater than 30%, for example greater than 40%,₁ relative to the total weight of the liquid fatty phase, or from 50% to 100%, of at least one apolar, such as hydrocarbon-based, oil. For the purposes of the invention, the expression "hydrocarbon-based oil" means an oil comprising carbon and hydrogen atoms, optionally with at least one group chosen from hydroxyl, ester, carboxyl,₁ and ether groups. --

IN THE CLAIMS:

65. (Amended) The composition according to claim 64, wherein said at least one gum is chosen from alkylated guar gums.

69. (Amended) The composition according to claim 66, wherein said quaternary ammonium compounds are chosen from quaternary ammonium salts of the formula

[wherein R₁, R₂, R₃, and R₄ are each independently chosen from an aliphatic]



wherein R₁, R₂, R₃, and R₄ are each independently chosen from an aliphatic group of from 1 to 22 carbon atoms, C₁-C₃ alkyls, hydroxyalkyls, polyalkoxys, aromatic groups having from 12 to 22 carbon atoms, aryl groups having from 12 to 22 carbon atoms, and alkylaryl groups having from 12 to 22 carbon atoms; and

X is chosen from halogen, acetate, phosphate, nitrate, and alkylsulfate radicals.

106. (Amended) The composition according to claim 105, wherein said at least one wax is chosen from carnauba wax, candelilla wax, ouricury wax, Japan wax, cork fiber wax, sugar cane wax, paraffin waxes, lignite wax, microcrystalline waxes, lanolin wax, montan wax, polyethylene waxes, waxes obtained by Fischer-Tropsch synthesis,

silicone waxes, ozokerites, hydrogenated jojoba oil, fatty acid esters, and fatty acid ester glycerides.

186. (Amended) The composition according to claim [1]108, wherein said at least one oil-soluble cationic surfactant is lauryl methyl gluceth-10-hydroxypropyl dimmonium chloride.

187. (Amended) The composition according to claim 108[1], wherein said at least one oil-soluble cationic surfactant is present in an amount ranging from 0.1% to 10% by weight of the total weight of said composition.

211. (Amended) The composition according to claim 210₁, wherein said at least one wax is chosen from carnauba wax, candelilla wax, ouricury wax, Japan wax, cork fiber wax, sugar cane wax, paraffin waxes, lignite wax, microcrystalline waxes, lanolin wax, montan wax, polyethylene waxes, waxes obtained by Fischer-Tropsch synthesis, silicone waxes, ozokerites, hydrogenated jojoba oil, fatty acid esters, and fatty acid ester glycerides.

318. (Amended) The anhydrous composition according to claim 317₁, wherein said at least one wax is chosen from carnauba wax, candelilla wax, ouricury wax, Japan wax, cork fiber wax, sugar cane wax, paraffin waxes, lignite wax, microcrystalline waxes, lanolin wax, montan wax, polyethylene waxes, waxes obtained by Fischer-

Tropsch synthesis, silicone waxes, ozokerites, hydrogenated jojoba oil, fatty acid esters, and fatty acid ester glycerides.

324. (Amended) The anhydrous deodorant[composition] according to claim 323, wherein said anhydrous deodorant[composition] is a solid.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com